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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,620	08/03/2001	J. Dewey Weaver III	41061/261991	7509

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EXAMINER

TRUONG, THANHNGA B

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/921,620

Applicant(s)

WEAVER ET AL.

Examiner

Thanhnga Truong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4-8, 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayashi et al (US 5,822, 676).

a. Referring to claim 1:

i. Hayashi teaches:

(1) assigning serial number to a user terminal; receiving content to the user terminal; encrypting the content; embedding the serial number in the encrypted content; and decrypting the content if the serial number embedded in the encrypted content is the serial number associated with the user terminal [i.e., **Hayashi's invention overcomes the disadvantages of the prior art by providing a method and apparatus for encoding a serial number into a program event. The encoder embeds the serial number into the program event so that it is imperceptible to the user when the program event is played to the user. The embedded serial number is unique to the user so that any storage medium storing the program event can be traced back to the user. This encoding technique is especially useful in interactive systems where a server at the head end receives subscriber identification numbers along with subscriber requests for program events. Thus, in response to a subscriber request for a program event, the server can generate a serial number unique to the user. The serial number can include a time and date stamp, and a cyclic redundancy check code**

(column 2, lines 5-29). Furthermore, referring to Figure 7, using the decoder, law enforcement authorities can extract from the video cassette the serial number identifying the originating subscriber (column 5, lines 32-67 through column 6, lines 1-8)].

b. Referring to claim 4:

i. Hayashi further teaches:

(1) wherein the content comprises bits [i.e., the serial number decoder 702 operates as follows. The luminance filter 704 extracts the luminance component of the video signal from the VCR, and outputs those portions of the image containing encoded bits (step 800) (column 5, lines 40-43)].

c. Referring to claim 5:

i. Hayashi further teaches:

(1) storing the content [i.e., the embedded serial number is unique to the user so that any storage medium storing the program event can be traced back to the user (column 2, lines 10-12). Specifically, referring to Figure 2, the data storage vaults 205 are used to store the digital programming content and application programs, and the media servers 210 are used to retrieve the stored digital media and implement other commands in response to requests from the home terminal nodes (column 3, lines 19-25)].

d. Referring to claim 6:

i. Hayashi further teaches:

(1) simultaneously storing and displaying the content [i.e., Figure 2 presents an example of a service source used in the interactive communication system of Figure 1. As shown in Figure 2, one example of the service source 115 includes a number of data storage vaults 205, a number of media servers 210, and a cable TV feedline 215. The service source 200 utilizes data storage vaults 205 and media servers 210 to provide a variety of interactive digital services to the subscribers of the system, whereby interactive, that is a two-way electronic communication that involve user's requests or responses via cable television or a computer (column 3, lines 12-19)].

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e. Referring to claim 7:

i. This claim has limitations that is similar to those of claim 6, thus it is rejected with the same rationale applied against claim 6 above.

f. Referring to claim 8:

i. This claim has limitations that is similar to those of claim 1, thus it is rejected with the same rationale applied against claim 1 above. For further details, see also Figure 1 and 4, column 2, lines 65-67 through column 3, lines 1-11, and column 3, lines 53-65.

g. Referring to claim 11:

i. This claim has limitations that is similar to those of claim 4, thus it is rejected with the same rationale applied against claim 4 above.

h. Referring to claim 12:

i. Hayashi further teaches:

(1) a storage drive in communication with said processor module, wherein said processor module is further configured to store said content on said processor module [i.e., as shown in Figure 4, the set-top 400 includes an internal bus 405, a processor 410, a random access memory (RAM) 415, a read-only memory (ROM) 420, a network interface 425, and an infra-red (IR) controller 430. Bus 405 represents the collective communication interface between the numerous internal modules of the set-top 400. In addition, this set-top uses processor 410 for processing digital signals, thereby controlling the operation of the set-top. Processor 410 is directed by the firmware and software instructions that respectively reside in ROM 420 and RAM 415. Moreover, the set-top 400 also uses RAM 415 to store temporary variables or other intermediate information during the operation of the processor (column 3, lines 53-65)].

i. Referring to claim 13:

i. This claim has limitations that is similar to those of claim 6, thus it is rejected with the same rationale applied against claim 6 above.

j. Referring to claim 14:

i. This claim has limitations that is similar to those of claim 12, thus it is rejected with the same rationale applied against claim 12 above.

k. Referring to claim 15:

i. This claim has limitations that is similar to those of claims 1, 6, and 7, thus it is rejected with the same rationale applied against claims 1, 6, and 7 above.

l. Referring to claim 16:

i. This claim has limitations that is similar to those of claims 1, 5, 6, and 12, thus it is rejected with the same rationale applied against claims 1, 5, 6, and 12 above. For further details, see also Figure 1 and column 2, lines 65-67 through column 3, lines 1-11.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al, and further in view of Sudia et al (US5,995,625).

a. Referring to claims 2-3:

i. Hayashi teaches the claimed subject matter along with the encoding technique, however Hayashi does not clearly point out the use of:

(1) wrapping the content.; scrambling the content.

ii. Sudia teaches :

(1) providing a digital data product that is wrapped using a key generated from a particular assent or acceptance phrase and from conditions of use of the digital data (column 2, lines 1-5). In addition, delivery to an end user of electronic (digital) goods in an encrypted (or scrambled) state is well known (**column 1, lines 49-56**).

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iii. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to:

(1) clearly point out the use of Hayashi's encoding technique to packing of digital data, and, more particularly, to packing digital data such that the packaged data is unusable while packed and such that the packaged data must be unpacked to be used **(column 1, lines 4-7 of Sudia)**.

iv. The ordinary skilled person would have been motivated to:

(1) clearly point out the use of Hayashi's encoding technique since the problem of binding the user to the terms and conditions of an electronic transaction system (generally known as system rules) is very important. Not only must the user be bound to perform (prepare and send) his own transactions according to certain rules, but he must also agree to reject certain transactions sent to him by other participants if those transactions violate certain rules. An example of this is the obligation of a recipient to disregard a transaction which does not match the authorization given to its sender, when verified according to the electronic commerce system being employed by the recipient **(column 1, lines 36-48 of Sudia)**.

b. Referring to claims 9-10:

i. These claims have limitations that is similar to those of claims 2 and 3, thus it is rejected with the same rationale applied against claims 2 and 3 above.

### **Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Nemirofsky (US 5, 412, 416) discloses the present invention provides a distribution network for full motion video media, usually in the form of advertisements, allowing video programs to be transmitted from a distribution center (DC) to a multitude of receiving sites (RS), typically retail stores, dispersed over a wide geographic area. Preferably, programs are transmitted via satellite (8) and are receivable via antennae (10) at the receiving sites (RS). Television monitors (14)

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located at selected points in the receiving sites display the programs to an audience, which usually will include shoppers in the course of shopping (see abstract).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanhnga (Tanya) Truong whose telephone number is 571-272-3858.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached at 571-272-3859. The fax and phone numbers for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2100.

TBT

November 9, 2004

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
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